

REMARKS***Claim Disposition***

Claims 1 – 25 are pending in the application. Claims 8 – 17 and 23 – 25 have been withdrawn from consideration subject to a restriction and election. Claims 1-7 and 18-22 stand rejected

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-7 and 18-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kimmlingen et al. United States Patent No. 6,418,336 (hereinafter Kimmlingen '336) in view of Katznelson et al. United States Patent No. 5,736,858 (hereinafter Katznelson '858).

Applicants respectfully point out once again that the Examiner has provided a single rejection with respect to a grouping of all claims. No justification or support has been provided for the motivation for making the suggested combination. Applicants respectfully direct the Examiner's attention to note the arguments directed to these issues were presented with the response of September 24, 2003, however, these arguments were not addressed. Applicants have expanded and clarified t Applicants respectfully suggest once again, that the Office Action is incomplete for failing to provide a clear disposition of all claims. Moreover, the rejections are unclear because the claims are grouped together despite the fact that some independent claims include limitations that others do not. "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." MPEP §707.07(d). Claim 5, for example, particularly includes limitations not in Claim 1. There is no explanation as to where each of the elements of Claim 5 are taught in the cited references, and in fact, they are not. Applicants have provided a response and explanation to the best

address the rejections in light of the ambiguity. Should the Examiner not find the arguments herein persuasive, Applicants respectfully request a new Office action with a new period for response.

Regarding Claims 1 – 7 and 18 - 22:

Applicants respectfully contend, that the explanation provided with the office action mischaracterizes the disclosures of Kimmlingen '336 and Katznelson '858, and further contends that the inclusion of such coils in a system such as Kimmlingen would not have obvious to the artisan of ordinary skill in the art at the time that the invention was made. The Examiner suggests that:

“Kimmlingen discloses a multiple portion coil system for MRI. Applicant’s attention is directed to the description of Fig. 1 and claim 1 of the Kimmlingen disclosure. The multiple portion coil allows for imaging in a plurality of fields of view as most simply described in the abstract of the disclosure. Note that the multiple portion coil is a Z-gradient coil. The only difference between Kimmlingen and the claims at issue is that Kimmlingen does not specifically show or explicitly describe the other two gradient coils, that is the X-gradient and Y-gradient coils.

The inclusion of such coils in a system such as Kimmlingen, would have been obvious to the artisan of ordinary skill in the art. It is well known that for MRI three sets of orthogonal gradients would be needed. See for example lines 25-45 of col. 1 of Katznelson.”

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143

Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Finally, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing ... that the proposed modification of the prior art must have had a reasonable expectation of success. MPEP 2143.02. Moreover, the suggested modification cannot change the principle of operation of a reference. MPEP 2143.01.

Applicants respectfully contend, that the explanation provided with the office action mischaracterizes the disclosure of Kimmlingen '336 and Katznelson '858 and it provides **no justification** for the suggested combination of Kimmlingen '336 with Katznelson '858. In particular, assuming arguendo that Kimmlingen '336 and Katznelson '858 in combination, disclose the elements of the claimed invention as suggested, there is no motivation in the cited references or the art to make the combination. In fact, Kimmlingen '336 specifically teaches away from the suggested combination by requiring "at least two imaging regions" and "at least two independently controllable coils portions" in the coils (Claim 1). Furthermore, were the invention obvious as the Examiner suggests, Kimmlingen '336 would have recognized the benefits of not requiring multiple coils for each axis as the Applicants have done, not only for the reductions in peripheral nerve stimulation, but also for reduced coil size, power, and heating. It is precisely this recognition, as is clearly taught in the specification that distinguishes the claimed invention from the cited references. In fact, the Examiner acknowledged this distinction with the Response to

Arguments stating: "As a matter of fact, what is special or "inventive" if you will, in Kimmlingen as well as the instant application, is the generation of more than one FOV from a gradient coil or coils." However, neither Kimmlingen '336, Katznelson '858, nor the existing art recognized the benefit of employing multiple coils in one particular axis and single coils in the others as the Applicants have done. Therefore, because neither Kimmlingen '336, Katznelson '858, nor the existing art provide any suggestion or motivation for the combination of the cited references they may not be employed to render the Applicant's claims unpatentable. Thus, Claim 1 - 7 and 18 - 22 are allowable, the rejections are improper, and they should be withdrawn.

Claims 2 - 4, 6 - 7, and 19 - 21 include the same limitations as Claims 1, 5, and 18 respectively, and therefore, are also allowable and are improperly rejected. Thus, the rejections of Claims 2 - 4, 6 - 7, and 19 - 21 should be withdrawn. Moreover, Claims 2 - 4, 6 - 7, and 19 - 21 depend from Claims 1, 5, and 18 respectively, which are allowable based upon the above presented arguments, and thus Claims 2 - 4, 6 - 7, and 19 - 21 are allowable as well.

Finally, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing ... that the proposed modification of the prior art must have had a reasonable expectation of success. MPEP 2143.02. Moreover, the suggested modification cannot change the principle of operation of a reference. MPEP 2143.01. Making the suggested modification to Kimmlingen '336 would be in direct contravention to its teachings and therefore change a principle of operation taught therein. Such a modification is not permissible. Therefore, once again the Examiner has not made a prima facie case for obviousness. Thus, neither Kimmlingen '336 nor Katznelson '858 may be employed to render the Applicants claims unpatentable. Thus, Claims 1 - 7 and 18 - 22 are allowable, the rejections are improper, and they should be withdrawn.

The arguments presented herein are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims were not amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that

subject matter or equivalents thereof to which the Applicants are entitled has been surrendered. Allowance of the claims is respectfully requested in view of the amendments and following remarks. Moreover, no amendments as presented alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection. It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicants. Accordingly, reconsideration and withdrawal of the rejections are requested.

In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are additional charges with respect to this matter or otherwise, please charge them to Deposit Account No. 07-0845.

Respectfully Submitted,

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